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Supreme Court of the United States

October Term, 1938

No. 222

THE WASHINGTONIAN PUBLISHING COMPANY, INC.,
Petitioner,

v.

DREW PEARSON, ROBERT S. ALLEN and VAN REES PRESS, INC.,
Respondents.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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The respondents, Drew Pearson, Robert S. Allen, and Van Rees Press, Inc., in opposition to the petition filed herein by The Washingtonian Publishing Company, Inc., for a writ of certiorari to the United States Court of Appeals for the District of Columbia, respectfully state to this Honorable Court:

I

THE FACTS

In December, 1931, and for some time prior thereto, the petitioner was the owner and publisher at Washington, D. C., of a monthly magazine of general circulation called THE WASHINGTONIAN. On December 10, 1931, the petitioner published an issue of THE WASHINGTONIAN claiming copyright upon the contents thereof by means of

the usual printed notice. However, the claim was not thereupon registered and copies were not thereupon deposited in the Copyright Office. The said December issue contained, among other material, a featured article entitled "The Mills—of the Gods" written by one Rixie Smith under the pen name of Linthicum Hall. *The petitioner discontinued publication after this issue.*

On August 25, 1932, Liveright, Inc., one of the defendants below, published and offered for general sale a book entitled "More Merry-Go-Round" written by respondents Pearson and Allen and printed by respondent Van Rees Press, Inc. This book included a chapter entitled "The Wizards of Reconstruction" which contained matter practically identical with the said article by Rixie Smith in the December, 1931, issue of THE WASHINGTONIAN.

Copyright of the book "More Merry-Go-Round" was claimed by means of the usual printed notice and, on August 26, 1932, Liveright, Inc., the publisher thereof, deposited two copies of the said book, together with the claim of copyright, in the Copyright Office, paid the fee, and obtained a certificate of registration. On December 14, 1932, the last edition of "More Merry-Go-Round" was printed.

On February 21, 1933, petitioner deposited copies of the December, 1931, issue of THE WASHINGTONIAN, together with claim of copyright, in the Copyright Office, paid the fee, and secured a certificate of registration. On the same day petitioner likewise deposited copies and obtained registrations of claim of copyright of the other eleven issues—January through November—of 1931.

On March 8, 1933, petitioner instituted this suit alleging infringement of the article appearing in the December, 1931, issue of THE WASHINGTONIAN.

All of the foregoing facts were found by the District Court and appear in the "Findings of Fact". (R. 27-28.)

Liveright, Inc., was adjudged bankrupt in June, 1933, and was not thereafter concerned with this proceeding. The trial occurred in February, 1935.

On March 28, 1935, the District Court, through Mr. Justice Letts, rendered an opinion (R. 23-26) finding the foregoing facts and holding that the bill should be dismissed because of the failure of The Washingtonian Publishing Company to comply with the provisions of the Copyright Act requiring the prompt deposit of copies.

In February, 1936, Mr. Justice Letts granted a rehearing. During the latter part of October, 1936, he notified counsel for the parties that he would decide in favor of the petitioner but that there would be *no opinion.* Findings of Fact and Conclusions of Law (R. 27-29) and a Decree (R. 29-30) were filed in December, 1936.

An appeal was taken to the United States Court of Appeals for the District of Columbia and, in April, 1938, that Court reversed the District Court upon the ground that the Copyright Act did not give retroactive effect to "grossly tardy compliance" with the law, and that petitioner could not thus establish, *ab initio,* its right to maintain an action against one who in the interim had acted adversely to its interest. (R. 42.)

II

QUESTION PRESENTED

The question presented is whether a copyright claimant who has failed to comply with the provision of the Copyright Act requiring *prompt* deposit of copies may maintain an action for an alleged infringement occurring long after publication and long before any effort whatsoever has been made to deposit copies.

III

STATUTE INVOLVED

Although incidental reference may be made to other provisions of the Copyright Act of 1909, as amended, the sec-

tion which gives rise to the question presented is Section 12 (35 Stat. 1078, 17 U. S. C. A. § 12). Insofar as it is pertinent to this discussion that section provides:

> "That after copyright has been secured by publication of the work with the notice of copyright as provided in Section 9 of this Act, there shall be *promptly deposited* in the Copyright Office or in the mail, addressed to the Register of Copyrights, Washington, District of Columbia, two complete copies of the best edition thereof then published, . . . to be accompanied in each case by a *claim of copyright. No action or proceeding shall be maintained for infringement of copyright in any work until the provisions of this Act with respect to the deposit of copies and registration of such work shall have been complied with.*" (Emphasis supplied.)

IV

SUMMARY OF ARGUMENT

1. The case presents no difficulties; it merely afforded the appellate court an opportunity to apply fundamental rules of statutory construction enunciated by this Court.

2. There is no conflict with the Second Circuit, and there is complete harmony with the only case in point.

V

ARGUMENT

Point 1. The case presents no difficulties; it merely afforded the appellate court an opportunity to apply fundamental rules of statutory construction enunciated by this Court.

It is a well recognized rule of statutory construction that there must be substantial compliance with the statute; and that every act required which is jurisdictional or of the essence of the proceedings, or prescribed for the benefit of

the party to be affected thereby, *must* be done. This rule applies to copyrights. See Sutherland on *Statutory Construction* (2d Ed., Vol. II, pp. 1140, 1142). The application of the general rule to copyrights was recognized by this Court in *Wheaton* v. *Peters*, 8 Pet. 591, 665, 8 L. ed. 1055, 1082:

> "*All the conditions are important; the law requires them to be performed;* and consequently *their performance is essential to a perfect title.* On the performance of a part of them the right vests; and this was essential to its protection under the statute; but other acts are to be done, *unless Congress have legislated in vain,* to render the right perfect." (Emphasis supplied.)

Many cases have reflected this pronouncement, including *Freeman* v. *The Trade Register, Inc.*, 173 Fed. 419. 421; *New York Times Co.* v. *Sun Printing & Publishing Association*, 204 Fed. 586; *Universal Film Manufacturing Co.* v. *Copperman*, 212 Fed. 301; *E. I. Horsman & Aetna Doll Co.* v. *Kaufman*, 286 Fed. 372; and *United Thrift Plan, Inc.* v. *National Thrift Plan, Inc.*, 34 F. (2d) 300.

The requirement of Section 12 is so very clear that it really needs no interpretation or elaboration. However, for convenience, and in order to incorporate the references therein, it may well be read as follows:

> "No action or proceeding shall be maintained for infringement of copyright in any work until two copies of the work shall have been *promptly* deposited in the Copyright Office as above required, and registration of the claim to copyright has been secured pursuant to Section 10." *

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* Section 10 provides "That such person may obtain registration of his claim to copyright by complying with the provisions of this Act, including the deposit of copies, and upon such compliance the register of copyrights shall issue to him the certificate provided for in section fifty-five of this Act." 17 U. S. C. A. §10.

In order to give effect to the requirement of *prompt* deposit of copies no other construction of Section 12 is possible. This fact was recognized by the appellate court in its decision (R. 38):

> "It must be conceded that appellee [petitioner] could not maintain an action for infringement at the time of publication of 'More Merry-Go-Round' or for six months thereafter. Fourteen months having elapsed since publication and claim of copyright, and six months having elapsed since the alleged infringement, appellee [petitioner] undertakes to comply with the Statute and thus to remove the restriction which impedes action. What must it do? *Section 12 provides that it must promptly deposit two copies. It does not say merely to deposit, but that the deposit must be promptly made; and promptness must be measured from the date of publication. Unless it can be said, therefore, that a delay of fourteen months is promptness, appellee [petitioner] has failed to comply with the Act.*" (Emphasis supplied.)

The court had no difficulty in finding (R. 39) that petitioner's delay of fourteen months could, in no sense, be deemed prompt deposit. As a matter of fact, petitioner itself has never contended that its deposit of copies was promptly made as required by Section 12. Therefore, the appellate court only had to decide whether the petitioner's failure to deposit copies as contemplated by the statute prevented the maintenance of an action against respondents for the use of certain material six months before petitioner made any effort to deposit copies of the publication containing such material. The court concluded (R. 42) that the petitioner could not maintain an action under such circumstances and cited, as an additional reason, the fact that respondents may have acquired intervening rights (R. 42, footnote) as against petitioner because of the latter's tardiness in depositing copies.

Point 2. There is no conflict with the Second Circuit, and there is complete harmony with the only case in point.

Counsel for petitioner refer to *Lumière* v. *Pathé Exchange*, 275 Fed. 428, as the only American case decisive of the point here raised. The only trouble is that the facts make it inapplicable. It involves solely the question of a proper *registration* of copyright, the registration which was first secured having been inadequate for the purpose intended.

The copyright in question was that of a photograph. Under the law it was necessary promptly to deposit one copy if the article were not to be reproduced for sale and two copies if it were. In each case a certificate of registration was only required before a suit for infringement could be instituted, but where no sale was contemplated it was not necessary to include in the certificate the date of first publication, whereas if sale were contemplated the date of the publication was required to be set forth.

Inasmuch as sale was contemplated, *two copies of the photograph were promptly deposited* as required. However, the certificate of registration gave no date of publication and therefore was only good for photographs *not* to be reproduced for sale. This was the situation when the suit was instituted for infringement of the copyright. The District Court dismissed the bill without prejudice to the right of the plaintiff to institute another action after he had secured a certificate of registration for photographs to be reproduced for sale. Both parties appealed, each contending that a decree should have been entered on the merits in his favor.

The Circuit Court of Appeals for the Second Circuit affirmed the action of the District Court in dismissing the bill but, in addition, stated that "the right to recover for infringement committed before a certificate of registration for copies to be reproduced for sale had been obtained

would continue." *There was no question concerning the deposit of copies "promptly" or otherwise.* There had been full compliance with the statute in this regard. In fact, the law had been complied with in every respect except furnishing the date of publication. The name of the proprietor of the copyright was given; the subject of the copyright was described; and two copies of the copyrighted article were available for inspection by any parties interested. The fundamental requirement of the law, as expressed in *Koppel* v. *Downing*,* 11 App. D. C. 93, had thus been met. The only question involved was the *incompleteness of the registration.* The Copyright Act does not require prompt registration; in fact, there is no registration actually required unless suit is contemplated. Section 10 provides that any person "*may* obtain registration of his claim to copyright", but Section 12 provides that two copies "*shall* be promptly deposited".

The appellate court considered the *Lumière* case and concluded (R. 41-42) that it—

> ". . . did not decide the question of the present case. The Court in that case expressly avoided consideration of 'Other important and difficult questions depending upon the construction of the Copyright Act . . .' And in his concurring opinion, Hough, J., said:

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* In that case the court stated (p. 104):

". . . The law of copyright, while securing a long continued monopoly, contemplates, and the policy of it requires, that the public should have notice, by a true and correct official registry, as to the real author or proprietor entitled to the enjoyment of such monopoly as against the public. . . ."

Later in the same case the court quoted (p. 106) from *Boucicault* v. *Hart*, 13 Blatch. 47, 54 (wherein the plaintiff had claimed that his right was sufficiently perfected by filing the title page only), the observation—

". . . that an author or inventor must put his claim in the form of a well-defined specification, work or composition, and so place it on record, so that he cannot alter it to suit his circumstances, and so that other authors and inventors may know precisely what it is that has been written or invented."

'I agree with the foregoing opinion *as far as it goes.* There are, however, two points for which this decision will by inference be thought authority and as to which I do not wish to be concluded. They are: (1) . . . and (2) whether in any form of action plaintiff can recover damages for infringements committed *before he* not only registered his claim of copyright, but *deposited the requisite number of* copies.' (Italics supplied.)

"Judge Hough's second reserved point is the one with which we are concerned."

The petitioner also refers (brief, p. 12) to certain English cases and asserts that the English courts placed the same construction upon the English copyright law as our Court of Appeals for the Second Circuit placed upon our Copyright Act in the *Lumière* case. Even so, it can make no difference because only the question of *registration* was involved. The question of prompt deposit could not possibly be involved in any English case because *under the English law there was no requirement for the deposit of copies either promptly or at any time whatsoever.* In fact, the law specifically stated that only registration was required, and this could safely be accomplished at any time prior to the institution of a suit for infringement. (See *Literary Copyright Act,* 1842, 5 and 6 Victoria, c. 45, under which the said English cases arose.)

Instead of the *Lumière* case being the only American case directly in point, as the petitioner would have this Court believe, that distinction must be accorded the more recent (1935) decision of the District Court for the Eastern District of Pennsylvania in *Ebeling & Reuss, Inc.* v. *Raff, Collector, and Wright, Tyndale & Van Roden, Inc.,* 28 U. S. P. Q. 366. That case involved the specific question of prompt deposit and the Court held that neglect to observe the statutory requirement was fatal to the right to maintain any action regardless, apparently, of whether the alleged infringement occurred before or after the tardy

deposit. The appellate court herein did not go that far, but limited its decision to publications appearing *before* deposit by the dilatory claimant. However, the two cases are in entire harmony in recognizing the fact that the requirement of prompt deposit is definitely related to the maintenance of an action of infringement. The petitioner recommends that the requirement be *ignored,* or at least considered in connection with some other section of the statute. The respondents rely upon the Copyright Act as it was enacted by the Congress. Unless and until it is appropriately changed a claimant cannot maintain an action under the circumstances of this case.

VI

SUMMARY AND CONCLUSION

Petitioner published and claimed a copyright in December, 1931; respondents published, deposited copies and claimed a copyright on similar material eight months later, in August, 1932; and petitioner deposited copies in February, 1933, fourteen months after its own publication and six months after respondents' publication. According to Section 12 of the Copyright Act no copyright claimant may maintain any action for infringement until it has promptly deposited copies of its work after publication and secured registration thereof. The appellate court found no difficulty in applying the fundamental rule of statutory construction and requiring substantial compliance with the terms of Section 12 in regard to deposit of copies. There could be but one result. Petitioner's right to maintain an action against respondents for a publication occurring *before* it had made any effort to comply with the statute was barred. As noted (R. 42) by the appellate court, it is not necessary to determine whether petitioner would have any right to maintain the action if the publication in question had occurred *after* petitioner's tardy deposit of copies.

The *Lumière* case, which petitioner contends is decisive of the point here presented, did not even involve any question of prompt deposit but only of *incompleteness of registration.* The *Ebeling & Reuss* case is the only one which involved *prompt deposit* and there it was held that strict compliance with the statute was necessary. In the instant case the appellate court was not required to go that far in its ruling because the respondents utilized the material in question many months *before* petitioner made any effort to comply with the requirement regarding deposit.

The present case involves an isolated question. The decision is not in conflict with that of any other court. Only fundamental rules of statutory construction are involved and their application here presents no unusual problem. The Court of Appeals for the District of Columbia merely followed and applied established principles which could here lead only to one conclusion—judgment for respondents. Therefore, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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